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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,188	03/10/2004	Charles A. Rosenblatt	5793.3124-00	2746
22852	7590	11/14/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,188

Applicant(s)

ROSENBLATT, CHARLES A.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on pre appeal conf request (7/21/06).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11-18,20,21,23-30,32,33 and 35-39 is/are rejected.
- 7) ☒ Claim(s) 7,10,19,22,31 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Pre Appeal Conference

1. During the Pre Appeal Conference, a determination was made that the case to be re-
5 opened for prosecution. Accordingly, this action is made non-final.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

10 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 13, and 25 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

15 Re claim 1 recites “a method, performed by a processor Receiving.....; storing.....; and preparing” The method is performed within the processor except when perhaps receiving information from a consumer, does not produce a tangible outcome. If a communication prepared in preparing step is delivered to the recipient, the method, in the Examiner’s opinion, would overcome 35 U.S.C. 101 rejection. For now, claim 1 is a method
20 performed by and within the processor. Claim 13 is directed at a system; and claim 25 is directed at a computer-readable medium, essentially claiming the same subject matter.

Re claims 2-12, 14-24, and 26-39 are rejected under 35 U.S.C. 101 as being dependent on one of claims 1, 13, and 25.

25

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8, 9, 11-17, 21, 23-30, 32, 33, and 35-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Messner (US 6,370,514, hereinafter “Messner”).

Re claims 1, 11, 13, 23, 25, and 35, Messner discloses a method, system and program
10 residing on computer readable medium for purchasing a gift/finance card (col. 6, lines 44-45) to a recipient; receiving financial card distribution information (col. 2, lines 16+); the purchaser can set a predetermined delivery time when the card to be delivered to the recipient (col. 9, lines 9-17); the voucher (gift card, whether it is a virtual or real one) keeps purchaser and card information in the database (col. 1, lines 25+); and preparing a communication to the recipient to
15 provide the financial card to the recipient via mail or email (col. 3, lines 3+).

Re claims 2, 14, and 26, the gift card (or certificate) contains an account number (col. 6, lines 24-49).

Re claims 3, 15, and 27, the card is a gift card (col. 6, lines 44-45; col. 9, line 26).

Re claims 4, 16, and 28, the card is loaded with an amount for the recipient to spend, for
20 example, \$50.00 (col. 3, lines 47+).

Re claims 5, 17, and 29, the purchaser determines the value of the prepaid/gift card (col. 2, lines 26+).

Re claims 9, 21, and 33, the purchaser may purchase the gift card with credit card (col. 8, lines 58+).

Re claims 12, 24, and 36, the email address or mailing address are personal information of the recipient (col. 3, lines 10+).

Re claims 8, 20, 32, and 37-39, the purchaser may purchase more than one card and assign different delivery dates for each card.

5

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15 6. Claims 6, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (US 6,370,514) in view of Phillips et al. (US 6,615,189, previously cited, hereinafter "Phillips").

The teachings of Messner have been discussed above.

20 Messner fails to specifically teach or fairly suggest an account associated with the delivered financial card is converted into a credit card account.

Phillips discloses a method for purchasing a prepaid card for a recipient (see abstract; col. 1, lines 34+). The account associated with purchase card can be converted into a recipient's credit account (col. 2, lines 30+).

25 In view of Phillips' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to convert prepaid card account to the recipient's credit card account in order to use existing account information to extend credit to potential credit customer.

Although the credit applicant goes through the application process, use of prepaid account would provide additional information determining applicant's credit worthiness. Accordingly, such modification would have been an obvious improvement one ordinary skill in the art would adopt.

5

Allowable Subject Matter

7. Claims 7, 10, 19, 22, 31, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10 8. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at a method, system and computer program for purchasing a financial card for a recipient. The card may be delivered at a predetermined time in the future. Purchaser's account may be charged at actual delivery time. The card may be pre-approved for converting to a credit card at a later time. Such feature is not disclosed or suggested by the cited references.

15

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru
20 Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ahshik Kim
Primary Examiner
Art Unit 2876
November 3, 2006